

“I Tweeted on Facebook Today:” Re-Evaluating Trademark Genericide of Internet-Based Trademarks

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Abstract: Has TWITTER become a generic trademark? Courts cannot properly answer this question because the trademark genericide doctrine was solidified prior to the internet-age and does not adequately address the effects of the modern marketing and quick proliferation of internet-based trademarks. In addition, because of the genericide avoidance strategies created in response to the judicial elements of genericide, trademark holders are wrongly constrained by inappropriate and outdated rules on how to use their marks. Because of these new realities of the Internet, the doctrine and judicial elements of genericide should be updated to reflect (1) new types of marketing including the verbing of trademarks and (2) internet service integration with third-party developers. Tailoring the judicial element to these new realities would allow for better economic opportunities through marketing for trademark holders as well as give courts a clearer view of the public's understanding of a trademark in order to determine if a mark has lost its distinctiveness and become generic. After proposing new elements to be considered in a genericide inquiry over internet-based trademarks, this note will apply the proposed new test to Twitter and its associated trademarks.

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I. INTRODUCTION

In February of 2010, before a crowd at a Tea Party Convention in Little Rock, Arkansas, ex-Vice Presidential hopeful Sarah Palin was asked what she believed was the number one threat to America today.¹ Before she could respond, several audience members shouted, “Obama!”² As the crowd laughed, she chimed in, “See, they said that, I didn’t. Just you watch now, too, because somebody will be here with their little twittering thing, and it’s going to be on the Internet any minute now.”³

In order to disclaim credit for such a direct attack on a political rival (and the current President of the United States), Ms. Palin decided to lighten the mood and poke fun at the political realities inherent in the instant communication available through social networking on the Internet. However, what was at no time apparent in Ms. Palin’s comment is that TWITTER is a trademark.⁴ In fact, her usage of the word “twittering” sounded *generic*, a term of art in trademark law that signifies a type of a product or service rather than the source of that product or service.⁵ Her usage sounded more like a word suitable for the activity of publishing information on the Internet through a technological device—an activity that can be accomplished regardless of any specific provider.

While this may sound like her personal interpretation of the term, it is likely indicative of the public understanding of the trademark, and is not entirely at odds with Twitter’s own presentation of its marks.

¹ Scott Conroy, *Palin: Tea Partiers “Have to Pick a Party,”* CBSnews.com, Feb. 17, 2010, <http://www.cbsnews.com/stories/2010/02/17/politics/main6215033.shtml>.

² *Id.*

³ *Id.*

⁴ For purposes of clarity when discussing the usage of a term as a trademark, company name, or definition, I will use the following method to differentiate between usage: (1) when referring to the company name, the term will be capitalized (Twitter – the company); (2) when referring to the trademark, the term will be in all caps (TWITTER – the trademark); (3) when referring to the actual definition of the term, it will be in quotation marks (“twitter” – referencing the word as normally used in the English language). When the terms are within a quotation from a reference source, the original presentation of the term will be maintained and will often not be consistent with the differentiation method I will be using.

⁵ J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:1 (4th ed. 2009) (hereinafter MCCARTHY).

With media name-checking such as this, Twitter is gaining market share in the social networking market, but a real question exists as to whether it is doing so in a way that threatens the distinctiveness of its trademarks.

In short, brand-name ubiquity in modern commerce and culture is the ultimate peak of marketing achievement. From this perspective, there is no higher goal or accomplishment than having one's brand name be the foremost name for a product or service.⁶ However, if that mark becomes too ubiquitous and becomes most widely associated as a type of product or service and not with the source, trademark law will strip the trademark owner of its rights through the doctrine of genericide. While sounding particularly harsh, in the modern age, mark holders have been able to avoid genericide through the costly blueprint laid down by brands like Band-Aid and Xerox, two brands that were on the brink of becoming generic, but were able to adjust their paths and avoid this devastating loss of rights.

However, with the shift into the Internet age, marketing and product integration have moved light-years beyond the 1950s-era marketplace where the original genericide elements were established. Because of these changes, the current genericide elements do not adequately address the question of how the public understands internet-based marks.⁷ In response to this disparity between the judicial elements and marketplace reality, this note proposes several changes to the genericide doctrine and the judicial elements.

Part II of this note will explain the doctrine and history of genericide, including the judicial elements, as well as detail the related genericide avoidance strategies. It will then explain why the current genericide doctrine does not adequately work when analyzing modern Internet trademarks and offer support for why it is appropriate to update the doctrine. Part III will offer two updates that the doctrine and judicial elements should adopt. Finally, Part IV will take these updated elements and apply them to the popular social networking

⁶ Mathew Dick, *Why You Must Never Sellotape® a Xerox® into your Filofax®*, 11 BRAND MANAGEMENT No.6, 509 (2004) ("Of course, all trademark owners want their brands to become the talk of the town and to have their name on every consumer's lips. Indeed, is it not the highest compliment to be paid to a brand that it has become so successful as to become the leading, generic name for any similar product in its class?").

⁷ An internet-based mark is any trademark used chiefly in connection with a primarily internet-based service. Examples include EBAY, TWITTER, GOOGLE, FACEBOOK, and AMAZON. Each represents a different service, but is chiefly attached to an internet-based service.

site Twitter, to analyze whether TWITTER or any of its associated marks is currently generic.

II. THE DOCTRINE OF GENERICIDE: THE JUDICIAL TEST AND AVOIDANCE STRATEGIES

The purpose of a trademark is to identify the source of a good or service in order to distinguish the root of one source from another.⁸ In order for a mark to be valid and worthy of protection, it must be distinctive: the mark must be capable of indicating the source of the good or service.⁹ A generic name of a thing cannot be a trademark for that thing.¹⁰ For example, "apple" is not afforded trademark protection for a brand of apples; however, it may be afforded protection for an unrelated product, such as computers.¹¹ A generic term signifies a type or genus of a product or service, while a non-generic term will signify the source of the product.¹² While most generic marks simply would not be afforded protection in the first place, in trademark law, there has been a history of marks that were once valid becoming generic through public saturation and failure to properly inform the public of the source-indicating function of the mark. This odd and sudden death of a usually famous mark is known as trademark genericide. Some famous marks that lost protection through genericide include aspirin, shredded wheat, and escalator.¹³ All of these terms started as source identifiers, but for various reasons, became identified in the public's mind with the type of products to which they were attached.

In 1938, the Supreme Court held that for a seller to prove trademark significance in a term challenged as generic, it must be proven that the "primary significance of the term in the minds of the consuming public is not the product but the producer."¹⁴ If the

⁸ Lanham Act § 45, 15 U.S.C. § 1127 (2006).

⁹ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992).

¹⁰ MCCARTHY, *supra* note 5, § 12:1.

¹¹ *Id.*

¹² *Id.*

¹³ *Id.*

¹⁴ *Kellogg Co. v. Nat'l. Biscuit Co.*, 305 U.S. 111, 113 (1938).

primary significance of the mark is the product and not the source, the mark has become generic. Congress codified this formulation into federal law in the 1984 amendments to the Lanham Act.¹⁵

The circuit courts apply slightly different standards to analyze the question of determining primary significance. The Second Circuit uses the “substantial majority test,” asking what the primary significance of the mark is to a substantial majority of the consuming public.¹⁶ The Ninth Circuit utilizes McCarthy’s “Who are you—What are you?” test.¹⁷ A trademark answers the question “who are you?”, while a generic term answers the question “what are you?”¹⁸ Both tests are designed to answer the question of what the primary significance of the mark is to the public.

Genericide is usually raised as a defense in trademark infringement cases.¹⁹ If the plaintiff mark holder claiming infringement does not have a valid mark, then there can be no judicial finding of infringement and the defendant will prevail on the infringement claim. Thus, genericide is an absolute defense to infringement, even if actual infringement exists. The doctrine of genericide is so strong that it is even available as a defense to incontestable marks,²⁰ and once declared, will result in the

¹⁵ McCarthy, *supra* note 5, § 12:6; Lanham Act § 1, 15 U.S.C. § 1064 (2006) (“The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.”).

¹⁶ Murphy Bed Door Co., Inc. v. Interior Sleep Sys., Inc., 874 F.2d 95, 101 (C.A.2 N.Y. 1989); King-Seeley Thermos Co. v. Aladdin Indus., Inc., 321 F.2d 577, 579 (2d Cir. 1963).

¹⁷ MCCARTHY, *supra* note 5, § 12:1; U.S. Jaycees v. San Francisco Jr. Chamber of Commerce, 513 F.2d 1226, 1229 (9th Cir. 1975); Surgicenters of Am. v. Med. Dental Surgeries, Co., 601 F.2d 1011, 1016 fn.13 (9th Cir. 1979).

¹⁸ MCCARTHY, *supra* note 5, § 12:1.

¹⁹ Lanham Act § 14(3), 15 U.S.C. § 1064(3) (2006) (“At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 4 [15 USC 1054] or of subsection (a), (b), or (c) of section 2 [15 USC 1052] for a registration under this Act, or contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.”).

²⁰ “Incontestable mark” is a term of art in trademark law indicating a trademark that has gained enough protection under the Lanham Act to bypass many of the available challenges that the challengers to a trademark can make in a court proceeding. Lanham Act

cancellation of the mark.²¹ In addition, genericness is a question of fact and is subject to a clearly erroneous standard of review, making this finding difficult to overcome on appeal.²² For companies who have spent a great deal of time and money investing in a mark, a finding of genericide can be a nightmarish occurrence, stripping the holder of its exclusive right to the mark.

A. JUDICIAL FACTORS

Courts typically examine several elements to determine if a mark has become generic. Most are circumstantial indicators and some are afforded more weight than others. These circumstantial indicators of genericide include generic use by competitors that has not been contested by the plaintiff, the plaintiff's own use of the mark in a generic way, dictionary definitions, usage in the media, testimony of persons in the trade, and finally and less circumstantial, consumer surveys.²³ No single element is required and not all of them are dispositive proof of genericide, and thus courts must weigh the evidence as whole.²⁴

1. COMPETITOR USAGE OF THE MARK

By examining the competitor's use of the plaintiff's mark in a generic way, the courts are actually looking to see if the plaintiff adequately polices its mark in order to be afforded continued protection.²⁵ In the famous *King-Seeley Thermos Co. v. Aladdin Industries, Inc.* case, where the Second Circuit ruled that "thermos" had become a generic mark, the court explained that the term became a part of the public domain "because of the plaintiff's lack of

§ 33, 15 U.S.C. § 1115 ("To the extent that the right to use the registered mark has become incontestable under section 15 [15 USC 1065], the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce.").

²¹ *Id.*

²² MCCARTHY, *supra* note 5, § 12:12.

²³ *Id.*

²⁴ *Id.*

²⁵ *King-Seeley*, 321 F.2d at 579.

reasonable diligence in asserting and protecting its trademark rights in the word “Thermos.”²⁶ This type of evidence is probative of generic use because “[t]he more [often that] members of the public see a term used by competitors in the field, the less likely they will be to identify the term with one particular producer.”²⁷

2. THE TRADEMARK HOLDER’S USAGE OF THE MARK

Evidence that a proponent of a mark has itself used the term in a generic fashion is viewed by courts as compelling evidence of genericness.²⁸ The term “escalator” started out as a trademark but was found to be generic in 1950 by the US Patent Office (“USPTO”) because the term was “recognized by the general public as the name for a moving stairway and not the source thereof.”²⁹ The board was particularly compelled by the Otis Company’s own use of the mark in a generic sense.³⁰

The Otis Company had used its “escalator” mark generically in several patents issued to the company and had used the name in a generic sense in its own advertisements, stating: “Otis elevators Otis escalators.”³¹ Because “elevator” is a generic word, by pairing “escalator” with “elevator” in a parallel manner, the advertisement showed that “escalator” was being displayed in a generic way.³² In addition, because the term was displayed next to a trademark—especially considering the marketing strategies in that period of American commerce—the trademark emphasis was on the word “Otis,” making its secondary word, “escalator,” “obviously ha[ve] no trademark significance.”³³ Lastly, the board noted that employees of

²⁶ *Id.*

²⁷ *Classic Foods Int’l Corp. v. Kettle Foods, Inc.*, 468 F. Supp. 2d 1181, 1190 (C.D. Cal.2007).

²⁸ *Pilates, Inc. v. Current Concepts, Inc.*, 120 F. Supp. 2d 286, 299 (S.D.N.Y. 2000).

²⁹ *Haughton Elevator Co. v. Seeberger (Otis Elevator Co. Substituted)*, 85 U.S.P.Q. 80, 81 (Comm.Pat. & T.M. 1950).

³⁰ *Id.*

³¹ *Id.*

³² *Id.*

³³ *Id.*

the Otis Company had participated in a committee that helped to prepare the “Standard Safety Code for Elevators, Dumbwaiters, and Escalators.”³⁴ Within the code, the term “escalator” was defined as, “a moving inclined continuous stairway or runway used for raising or lowering passengers.”³⁵ In addition, throughout the code, the term was used descriptively to refer to moving stairs without any indication that it was a designation of the Otis Company.³⁶ In effect, the Otis Company’s “escalator” mark became generic through its own use, which the Review Board felt was compelling enough evidence to show that the public likely believed the term was a reference to the product and not to the source of the product.

3. DICTIONARY AND MEDIA USAGE

Courts often look to dictionary definitions of contested marks because of the assumption that dictionaries reflect the public’s perception of a word’s meaning and its contemporary usage.³⁷ The Second Circuit relied on dictionary definitions to find that “hog” was a generic term when used for motorcycles.³⁸ While courts sometimes find dictionary definitions to be significant evidence of genericide, the overtly circumstantial nature of the evidence makes them not wholly conclusive and typically requires additional corroborative evidence.³⁹

Generic usage of a mark in media, such as trade journals and newspapers, can be a “strong indication of the general public’s perception” that a term is generic.⁴⁰ The defendant in *Murphy Bed Door Co., Inc. v. Interior Sleep Systems, Inc.* was able to produce numerous examples of the public media using the phrase “murphy bed” to describe a type of bed that folds out of the wall, rather than as a term for a specific brand of beds.⁴¹ In finding “murphy bed” to be

³⁴ *Id.*

³⁵ *Id.*

³⁶ *Id.*

³⁷ *Harley Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 810 (2d Cir. 1999).

³⁸ *Id.* at 810, 811.

³⁹ *Id.* at 811.

⁴⁰ *Murphy Bed*, 874 F.2d at 101.

⁴¹ *Id.*

generic, the Second Circuit explained that while the dictionary definition was a strong indication, it was not alone “proof positive” of genericide.⁴²

In addition to the evidence of the public media using the term in a generic sense, the court noted that the term was included in many dictionaries as a standard description for that type of bed.⁴³ The court did note that the Murphy Company had put forth effort in policing its mark, but that the mark had “entered the public domain beyond recall,” and that policing that is too late is of “no consequence to a determination of genericide.”⁴⁴ In addition, the court even noted that other manufacturers did not use the term to describe their beds, but was still compelled by the dictionary and media evidence to find that the mark had succumbed to genericide.⁴⁵

4. TESTIMONY OF MEMBERS OF THE TRADE

Courts will often entertain testimony from members of the trade in question who are familiar with the language and usage of the mark in question in its specific marketplace.⁴⁶ However, it is of little value when the testimony comes from friendly employees or dealers, as such testimony would likely have the appearance of bias.⁴⁷

5. SURVEYS

In recent years, surveys have become heavily used in determinations of genericness.⁴⁸ In 1963, the Second Circuit relied heavily on survey results in ruling that “thermos” had become a generic mark.⁴⁹ While the court discussed at length the possibility that

⁴² *Id.*

⁴³ *Id.*

⁴⁴ *Id.*

⁴⁵ *Id.*

⁴⁶ MCCARTHY, *supra* note 5, § 12:13.

⁴⁷ *Id.*

⁴⁸ MCCARTHY, *supra* note 5, § 12:14.

⁴⁹ King-Seeley, 321 F.2d at 579.

King-Seeley's advertising plan in the early part of the 1900s may have played a role in turning "thermos" into a generic mark, the court was unequivocally compelled by survey evidence offered by the defendant showing that 75% of adults in the United States that were familiar with products that keep contents hot or cold called such a container a thermos.⁵⁰ Additionally, only 12% of the adult public was aware "Thermos had trademark significance," and only 11% used the alternative generic term "vacuum bottle" for these products.⁵¹

While surveys likely represent the truest indicator of public perception—the key issue at hand—surveys may be bypassed if other evidence overwhelmingly proves the mark in question is generic.⁵² As useful as they may be, surveys offer distinct challenges as they can be difficult to construct and the methods contained are often strongly challenged by the opposing party and judges.⁵³

B. THE GENERICIDE AVOIDANCE STRATEGIES: THE BLUEPRINT AND THE PROBLEMS

Through judicial opinions, scholastic analysis, and the blueprints written by the actions of famous genericide-avoiders like Xerox and Band-Aid, a well-known and widely accepted set of genericide avoidance strategies have developed.⁵⁴ The common proliferation of these strategies may be a result of the relatively few genericide cases and the lack of clarity in how to avoid genericide in the case law and Lanham Act. The general idea behind these strategies focuses on two

⁵⁰ *Id.* at 578, 579.

⁵¹ *Id.*

⁵² *Colt Def. LLC v. Bushmaster Firearms, Inc.*, 486 F.3d 701, n.4 (1st Cir. 2007).

⁵³ For an in-depth analysis of the current state of survey usage in trademark genericity cases, see E. Deborah Jay, *Genericness Surveys in Trademark Disputes: Evolution of Species*, 99 TRADEMARK REP. 1118 (2009).

⁵⁴ See, e.g., Charles R. Taylor and Michael G. Walsh, *Legal Strategies for Protecting Brands from Genericide: Recent Trends in Evidence Weight in Court Cases*, J. PUB POL'Y & MKTG, Vol. 21(1), Spring 2002, 160, 161 (term "genericide avoidance strategies" represents my term for the culmination and compiling of research into the various court recommendations, scholarly pontifications, and journalistic efforts made in discussing how trademark holders should avoid genericide); Quizlaw.com, *How Can I Avoid Genericide of My Trademark?*, http://www.quizlaw.com/trademarks/how_can_i_avoid_genericide_of.php (last visited Apr. 19, 2011) (hereinafter *Avoid Genericide*).

main actions: education of the public through advertising and promotion (whether early in the product life-cycle or later when a genericide issue becomes apparent) and aggressive and widespread policing of the usage of the mark by competitors and the media. One or both actions may be necessary to maintain the integrity of a mark; however, each has inherent economic costs.

1. *PROPER MARKETING OF A TRADEMARK*

Marketing one's product and trademark properly in the beginning of the product's lifecycle will help ensure that the mark does not become generic.⁵⁵ This can be accomplished by a clear delineation of the product and source identifiers in marketing and advertising.⁵⁶ However, if a brand fails to do this—or chooses not to, as many modern marketers may—certain actions can be taken in order to avoid genericide.

One of the earliest cases of genericide was the term “aspirin,” which was held to have become generic by Judge Learned Hand in 1921.⁵⁷ Judge Hand explained that Bayer was partly at fault for “aspirin” becoming generic for two specific actions it took.⁵⁸ First, from the period of 1904-1915, aspirin became a widely used over the counter drug and Bayer sold its aspirin product in packaging marked only “Aspirin” with no other information. This led consumers to believe “aspirin” was the name of the product and that it was “made by most large chemists indiscriminately.”⁵⁹ Next, in the autumn of 1915, Bayer began to package its product with a label reading: “Bayer - Tablets of Aspirin.”⁶⁰ Judge Hand noted that this phrase reads to mean that the tablets were Bayer's version of aspirin, presupposing that the consuming public read “aspirin” to denote a type of product.⁶¹ Because Bayer presented its mark improperly in two different ways,

⁵⁵ Taylor and Walsh, *supra* note 54, at 161.

⁵⁶ *See id.*

⁵⁷ Bayer Co., Inc. v. United Drug Co., 272 F. 505 (S.D.N.Y. 1921).

⁵⁸ *See id.* at 509-512.

⁵⁹ *Id.* at 511.

⁶⁰ *Id.* at 512.

⁶¹ *Id.*

its failure to properly plan and advertise appropriately led to the public's failure to understand its mark in a non-generic sense.

Another issue in many instances of genericide has been the lack of a secondary word for the product at issue, leading to a mark becoming more of a product identifier in the mind of the public. For instance, the public simply had no term other than "murphy bed" to refer to a bed that folds into the wall, causing the mark to pass into the public domain of words. When no secondary generic word for a product exists, the public often has no choice but to adopt the trademark as a generic product identifier. While this linguistic issue can happen with any type of product, it is most relevant for and most frequently occurs with new products.⁶²

While some products simply have no generic name, others may succumb to this linguistic problem because the generic secondary name is simply unworkable in a marketing approach. "Aspirin" had a secondary generic name attached to it: its scientific name, acetyl salicylic acid; however, it is not difficult to see why Bayer (who at the time had no reason to be concerned about the doctrine of genericide, as it was in its infancy) chose not to utilize the scientific name in its branding and advertising.⁶³

Furthermore, this linguistic issue could become relevant even for marks that do have a secondary name that might be workable in marketing, but the generic terms are simply unsatisfying to the public. The generic product names initially associated with the marks later held generic include "vacuum bottle" for "thermos;" "transparent cellulose sheet" for "cellophane;" and "business telephone directory" for "yellow pages."⁶⁴ In each of these instances, a secondary generic name did exist for the product, however the public adopted the associated trademark because it was more linguistically appealing and simpler to use. When confronted with the option of simple snappy terms or longer, more scientific terms, the human mind is quick to save mental space and adopt the simpler term.⁶⁵

⁶² See Devin R. Desai and Sandra L. Rierson, *Confronting the Genericide Conundrum*, 28 CARDOZO L. REV. 1789, 1821 (2007) (hereinafter Desai and Rierson) (alignment of a new product with a new name leading to trademark genericide has also been dubbed "death by patent," however the expiration of a patent does not require that the patent's corollary trademark be held generic).

⁶³ See *Bayer*, 272 F.505 at 510.

⁶⁴ MCCARTHY, *supra* note 5, § 12:18.

⁶⁵ For an in-depth analysis of the linguistic issues present in trademark genericide and the public's role in assigning words meaning, see Rochelle Cooper Dreyfuss, *Expressive*

In practice, this linguistic issue represents one of the major tensions of the genericide doctrine. In the modern marketplace of both commerce and language, trademark creators are often the creators of new words.⁶⁶ Especially when a company has created a new product, it must create a new word or term for the product. But in order to protect the source-indicating function of whatever term it uses, scholars note that it should also adopt a generic term for the mark.⁶⁷ If the company fails to adopt both a protected trademark and a generic term for the product, and the product becomes well known to the public, the eventual genericide of the trademark is likely because the public has no other option, as was the case with the “murphy bed.”

However, as Xerox and Band-Aid—two brands once on the brink of succumbing to genericide—have shown, public understanding can be re-shaped through marketing and advertising efforts. Band-Aid took a direct and logical approach to educating consumers in its advertising efforts. Most notably, it changed the lyrics of a popular jingle.⁶⁸ What began as, “I’m stuck on Band-Aid because Band-Aids stuck on me,” became “I’m stuck on Band-Aid *brand* because Band-Aids stuck on me.”⁶⁹

Xerox took an even more direct approach to combating generic usage of its mark. The company and its mark first rose to prominence in 1959 with the 914-model plain paper copier.⁷⁰ Because this was the first copier widely-known to the American public, people soon began to understand the mark “Xerox” primarily as a product identifier rather than as the source and began using the term as a verb and general catchall term for a photocopy.⁷¹ Realizing the risk of losing its

Genericity: Trademarks as Language in the Pepsi Generation, 65 NOTRE DAME L. REV. 397 (1990).

⁶⁶ See *id.* at 417.

⁶⁷ *Id.*

⁶⁸ John R. Kettle III, *What Every Litigator Must Know About Intellectual Property*, 798 PLI/PAT 53, 123 (2004).

⁶⁹ *Id.*

⁷⁰ National Museum of American History, Xerox 914 Plain Paper Copier, <http://americanhistory.si.edu/collections/object.cfm?key=35&objkey=191> (last visited Apr. 19, 2011).

⁷¹ For example, “Can you Xerox this for me?”

valuable mark, Xerox began engaging in a massive advertising campaign to educate consumers over the correct use of its mark.⁷²

2. PROPER POLICING OF COMPETITORS AND THE MEDIA

In addition to informing the consuming public of the trademark implications of a word, mark owners must police competitor usage of their mark, in addition to the usage of the mark in the media.⁷³ Policing competitor usage of a mark can be accomplished through cease and desist letters and, if necessary, several Lanham Act causes of action, including general infringement and dilution claims.⁷⁴

However, unlike the available causes of action against competitor usage, the law offers no clear legal remedy against generic usage of a trademark by dictionaries, newspapers, or other media.⁷⁵ Furthermore, courts have even noted that there would be First Amendment free speech implications in attempting to stop a dictionary or newspaper from using a term in any way it might choose, even if that usage is generic usage of a trademark.⁷⁶ Nevertheless, trademark holders must still—with no legal right to enforce—attempt to sway and convince publishers of the proper way in which to use their marks.⁷⁷

⁷² Desai and Rierison, *supra* note 62, at 1836; see Iowa Practice Series TM, Bus. Org., Other Issue for the Business Practitioner, 6 IOWA PRACTICE SERIES § 37:11 fn. 15 (2010), quoting TIME, September, 1969, p. 37. (“Xerox placed ads in magazines with strong text reading declarations such as, ‘Our lawyers can present their entire case in 25 words or less. Xerox is a registered trademark. It shouldn’t be used for anything anybody else makes. Our lawyers figure 25 words or less should be sufficient.’”).

⁷³ Desai and Rierison, *supra* note 62, at 1835.

⁷⁴ For general infringement claims see Lanham Act § 32, 15 U.S.C. § 1114. For dilution claims see Lanham Act § 43, 15 U.S.C. § 1125 (policing of competitor usage of one’s mark is a requirement to maintain a valid trademark in most trademark disputes).

⁷⁵ 37 AM. JUR. 2D *Proof Of Facts* 67 § 8 (2009) (there seem to be some state dilution statutes that may support a cause of action to enjoin a publisher’s usage of a trademark in a way that may dilute the mark; there is no such use as to date).

⁷⁶ Illinois High School Ass’n v. GTE Vantage, Inc., 99 F.3d 244, 246 (7th Cir. 1996) (“Because a court could not, without violating the free-speech clause of the First Amendment, have enjoined (or used other legal remedies to prevent or deter) the media from calling the NCAA tournament ‘March Madness,’ IHSA was helpless to prevent its trademark from being transformed into the name of another product.”).

⁷⁷ *Id.* (“A serious trademark holder is assiduous in endeavoring to convince dictionary editors, magazine and newspaper editors, journalists and columnists, judges, and other

In 2006, Google came under genericide scrutiny for the widespread and occasionally generic use of its mark by the media.⁷⁸ The Washington Post published an article discussing recent entry of “google” in the Merriam-Webster’s Collegiate Dictionary as a defined word and Google took particular offense to one passage: “Google, the word, now takes its place alongside the handful of proper nouns that have moved beyond a particular product to become descriptors of an entire sector — generic trademarks.”⁷⁹ Google followed the suggested path of the courts by responding to the article with a letter to the newspaper explaining that the article’s usage of their trademark was genericide and that this type of characterization should be avoided.⁸⁰ The letter even went on to give examples on how the term “Google” should properly be used: “Appropriate: He ego-surfs on the Google search engine to see if he’s listed in the results. Inappropriate: He googles himself.’...‘Appropriate: I ran a Google search to check out that guy from the party. ‘Inappropriate: I googled that hottie.’”⁸¹

3. LINGUISTIC ADVICE

Next, brand owners are often advised to take a variety of measures towards policing their own usage of their mark, both in common use by employees and in advertising. Frequent advice in the genericide avoidance strategies give special attention to the grammatical usage of the mark and the following suggested rules are actual measures taken from the genericide avoidance strategy literature. It should be noted that these canons of proper trademark use are not found in the Lanham Act or in any court case, although trademark scholars commonly express these ideas.⁸² The common linguistic rules are as follows:

lexicographically influential persons to avoid using his trademark to denote anything other than the trademarked good or service.”).

⁷⁸ Frank Ahrens, *Use Google, But Please Don’t “Google,” Search Engine Says*, WASH. POST, Aug. 6, 2006, available at http://seattletimes.nwsourc.com/html/business/technology/2003178630_google06.html.

⁷⁹ *Id.*

⁸⁰ *Id.*

⁸¹ *Id.*

⁸² Rose A. Hagan, *The Myths of Genericide*, 22:2 A.B.A. INTELL. PROP. L. NEWSLETTER 13 (2004), available at http://www.abanet.org/intelprop/bulletin/winter_04.pdf.

1. The trademark should never be used as a verb.
2. The trademark should be used as an adjective and never as a noun. For example, "CAMPBELL's soups" or "TOTES umbrellas" should be used in advertising and promotion, not "CAMPBELL's" or "TOTES" alone.
3. The trademark should be used as a proper adjective. Thus, promotion should refer to ROLLERBLADE inline skates and should not include lines such as "I want some Rollerblades."
4. The trademark should always be used in the singular. Advertising and public relations materials should never use a plural version of the trademark. For example, "EASY SPIRIT shoes" or "CRAYOLA crayons" should be used, but not "easy spirits" or "crayolas."
5. Possessives should be avoided in promotion. For example, "The great taste of HEINZ 57 Steak Sauce" is appropriate, but not "Heinz 57's great taste."⁸³

C. THE GENERICIDE DOCTRINE SHOULD BE UPDATED TO REFLECT THE NEW REALITIES OF THE INTERNET

The classic elements of the court test for genericide, and the subsequent genericide avoidance strategies, do not adequately satisfy the needs of evaluating genericide in the Internet context. Because the doctrine has not been updated to reflect modern marketing and Internet realities, it misses new opportunities to fully grasp the public's understanding of a specific internet-based trademark. In response to the recognition of the core principles of both trademark law and the genericide doctrine, these court-recognized genericide elements should not remain static, but should be tailored to match changing markets and technology, particularly when dealing with the internet. Further support for this idea exists in the case law; both in the ever-present notion that in trademark, context matters, and in the relevant trademark cases that have already adjusted traditional trademark doctrine to meet the economic realities of the Internet.

⁸³ *Avoid Genericide*, *supra* note 54; Taylor and Walsh, *supra* note 54, at 161.

1. THE CURRENT GENERICIDE DOCTRINE DOES NOT SPEAK TO THE REALITIES OF THE INTERNET

The current genericide doctrine leaves much to be desired when applied towards internet-based trademarks.⁸⁴ While still a valuable tool for the legal corraling of wayward marks, because this set of elements was based on a different and older marketplace, it seems that many internet mark holders do not actually take the possibility of genericide into serious consideration.⁸⁵ Either the economic costs of planning in advance are too high or mark holders are simply banking on the courts not being able to understand the Internet/trademark interaction enough to actually find genericide. Much has been written about the possibilities of genericide on the Internet; however, currently, there appear to be no internet-based marks that were once considered distinctive being held generic.

Two main forces separate the market landscape of the Internet from the comparatively pre-historic market of the original genericide cases: (1) advances in technology with corresponding effects on commerce and (2) modern-day approaches to marketing. With the rise in computer usage and the proliferation of the Internet, much of the consumption of products and services takes place with the aid of computers and the Internet. Because of the informational powers of technology, trademark owners are able to propagate their marks in a manner and with swiftness not previously possible. In addition, the speedy proliferation of technology has caused the public to manifest widely differing levels of user-sophistication.

Also, because of the integrative nature of modern technology and internet services, owners of computer program operating systems are allowing widespread third-party integration of their services, as discussed in detail in part III.B. The integrative nature of Internet services is enhanced by the phenomenon of network effect, where the value of a service is enhanced by an increase in the number of users.⁸⁶

⁸⁴ See generally, Matthew Dick, *supra* note 6 (an “internet-based mark” is any trademark used chiefly in connection with a primarily internet-based service).

⁸⁵ See Duetsblog.com, Managing the Legal Risk of “Verbing Up” Brands and Trademarks, <http://www.duetsblog.com/2010/05/articles/managing-the-legal-risk-of-verbing-up-brands-and-trademarks/> (May 10, 2010) (“A growing number of brand owners apparently are convinced the stated risk of genericide is either too remote or distant to fear, or at least that the marketing benefits of encouraging the verbing of their brands far exceeds losing all exclusive rights in the trademarks associated with those brands.”).

⁸⁶ See Network Effects, <http://moneyterms.co.uk/network-effects/> (last visited Apr. 19, 2011) (The classic illustrative example of the network effect in practice is the telephone.

In other words, the more people that use it, the better the service is for individual users. Once an Internet service network is established, if one internet service is the prevailing provider of that service, the network effect makes it more difficult for a competitor to disrupt the dominance of that primary service.⁸⁷ Because of the integrative purpose of Internet services, nearly every internet service is subject to some level of the network effect.

Next, the approaches taken by modern marketing have advanced beyond the straightforward print, television, and radio advertising of the past. Product owners prefer to augment more traditional styles of advertising with new types of marketing like viral marketing and integrated branding – approaches not utilized before the modern era of marketing.

However, in contrast to these new realities, the circumstantial judicial elements of genericide were mainly solidified in the 1950s and 1960s in the *Murphy Bed* and *King-Seeley Thermos* cases, with little variation since.⁸⁸ These cases were written without the existence of the internet or the current hot marketing approaches. While still maintaining usefulness, without expansion, the classic elements only adequately cover the economic realities of the 1950s and 1960s.

In response to the judicial elements of genericide, theorists created the strategies that are outlined in part II.B. While those methods represent the commonly advised paths towards avoiding genericide, implementing these methods have certain costs and other possible risks that make implementation towards internet-based marks inappropriate. For instance, policing of the public's understanding of the mark can be expensive.⁸⁹ In addition to the

The more that people that own a telephone, the more useful owning a telephone is to each person that owns one. For example, the power of EBay is enhanced by the network effect because the amount of users is so high that a new seller has more incentive to use EBay to sell an item because of its large user numbers. And likewise, new users add to the value of EBay by expanding its overall network).

⁸⁷ Because the network effect of a service hinders competition, once an internet service has become clearly dominant, the continued proliferation of the service and lack of valid competition might actually cut against a possibility of genericide. With market dominance, there is less of a chance for a competitor to support an alternative service where the trademark of the primary service could even be used to identify that type of service. If there is only one company widely known to offer the service, there is not truly an opportunity for the trademark to shift to only signify the type of service rather than the source.

⁸⁸ *Murphy Bed*, 874 F.2d at 101; *King-Seeley*, 321 F.2d at 579.

⁸⁹ Xerox spent a great deal of money placing its ads in Time Magazine, one of the highest read periodicals at the time and instead of being able to focus on promoting its newest

economic costs, there is no guarantee that such advertising will actually work.⁹⁰ Furthermore, the economic cost of implementing avoidance strategies is all the greater when one realizes that it is applied in response to a doctrine that is not properly tailored to the issue at hand.

Policing the media has its own specific risks as consumers may see it as an overly aggressive and possibly unethical tactic.⁹¹ If consumers are angered by a trademark owner's method of policing, the mark could lose brand equity, a particularly ironic outcome considering that the goal of policing is to protect the brand equity in question.

Finally, the avoidance strategies preach a particularly prudish approach to marketing. The best way to avoid genericide is to brand one's product in the classic word order of (1) the trademark, (2) the word "brand," and (3) the type of product; for instance "Camel brand cigarettes," however, this would not likely be considered an acceptable form of marketing for a modern product or service, especially on the internet. In addition, the prohibition on the usage of a trademark as any type of speech other than a noun does not allow for modern marketing possibilities. This issue will be addressed in detail in part III.A.

The genericide doctrine is a principle that should remain relevant in modern trademark law, and therefore to allow it to remain static with its doctrine based on a 1950s and 1960s-style economic marketplace would risk muting its importance and power. When new economic realities—such as the Internet—so require, the test should be updated in order to properly achieve its objectives.

product, the company had to expend resources to protect its trademark. *See* Iowa Practice Series, *supra* note 72.

⁹⁰ *King-Seeley*, 321 F.2d at 579 (King-Seeley had not properly protected its mark until the 1950s, but later had taken the proper steps to inform the public of the source-indicating function of "thermos." However, the court ruled that their remedial approach was too late to undo the damage caused by 27 years of generic proliferation of the mark. Not only was the economic cost likely great in changing its marketing approach, the company failed to protect the mark, representing a complete waste).

⁹¹ *See* Mathew Dick, *supra* note 6; Paul Ryan, *Google Wants You to Stop "Googling,"* AUSTRALIAN ANTHILL, Oct. 2006 at 74, available at <http://anthillonline.com/google-wants-you-to-stop-googling/> (Google experienced backlash when it began sending letters to the media regarding the usage of its trademark. Commentators saw the move as antithetical to its "Don't be evil" roots.).

2. THE TEST FOR TRADEMARK GENERICIDE SHOULD BE TAILORED FOR APPLICATION TO INTERNET-BASED TRADEMARKS

In addition to the recognition that the current genericide test does not speak to the realities of the internet marketplace, there exists support in case law, scholarly analysis, and the philosophies of trademark law for a genericide test tailored for application to internet-based marks.

A. THE CASE FOR TAILORING THE GENERICIDE TEST SPECIFICALLY FOR APPLICATION ON THE INTERNET

Specific support is available from both relevant case law and trademark scholars for the notion that trademark tests should be tailored specifically for application on the Internet. These cases and scholarly writings make clear that tailoring is appropriate because of the previously unseen marketing and economic realities of the Internet.

In 1999, the United States Court of Appeals for the Ninth Circuit noted that, in trademark, “[w]e must be acutely aware of excessive rigidity when applying the law in the Internet context; emerging technologies require a flexible approach.”⁹² A year later, the same court expanded on this in *Goto.com, Inc. v. Disney* when applying its circuit’s version of the likelihood of confusion test.⁹³ The court held that when applying the eight-factor test to infringement on the Internet, three elements in particular had enhanced importance.⁹⁴ The three highlighted elements were “(1) the similarity of the marks, (2) the relatedness of the goods or services, and (3) the ‘simultaneous use of the Web as a marketing channel’.”⁹⁵ By highlighting these three elements and tailoring the third of these specifically to the Internet, the court, in effect, created a new test for applying a likelihood of confusion analysis to the Internet that continues to be applied.⁹⁶

⁹² *Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1054 (9th Cir. 1999).

⁹³ *Goto.com v. Walt Disney Co.*, 202 F.3d 1199, 1205 (9th Cir. 2000).

⁹⁴ *Id.*

⁹⁵ *Id.* citing *Brookfield*, 174 F.3d at 1054 n. 16.

⁹⁶ *SMC Promotions, Inc. v. SMC Promotions*, 355 F.Supp.2d 1127, 1135 (C.D. Cal. 2005).

This internet-specific tailoring for trademark claims has been accepted and expanded on by scholars. Stacey L. Dogan and Mark A. Lemley explained that courts, when analyzing trademark claims on the Internet, must be proactive and forward-thinking; courts must consider themselves “norm creators, in the sense that the rules they develop will determine practices on the Web and whether the Internet realizes its potential as a vast clearinghouse of information and content.”⁹⁷ They go on to note that “the norms-creator role is particularly important in the fast-changing context of the Internet, in which both technology and user expectations are in rapid flux. Because of the absence of settled expectations, courts have a real opportunity to shape consumer expectations about Internet rights and practices at very little cost.”⁹⁸

The new realities of the Internet are abundant and powerful in ways that traditional trademark analyses cannot always account for. Because the Internet advances so rapidly and because its influence on commerce is so strong, courts have an affirmative duty to properly account for these changes by tailoring analyses when appropriate. The Ninth Circuit has already shown that trademark tests can be properly adjusted for application to the Internet, and many scholars agree that further tailoring would be appropriate for other trademark issues on the Internet. Because of this and the current problems with applying the genericide test, the analysis should be updated to reflect the new realities of the Internet.

B. THE GOALS OF TRADEMARK LAW SUPPORT TAILORED TESTS FOR RESOLVING INTERNET TRADEMARK ISSUES

The goals of trademark law are twofold: serving to (1) protect consumers from deceptive and confusing use of trade names and symbols and (2) protect trademark owners’ rights to exclusive use of the trademark.⁹⁹ When a mark is generic it cannot serve to identify

⁹⁷ Stacey L. Dogan and Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777, 784 (2004).

⁹⁸ *Id.* at 784 n.24.

⁹⁹ MCCARTHY, *supra* note 5, § 2:2; see S. REP. NO. 79-1333, at 3 (1946) (“The purpose underlying any trade-mark statute is twofold. One is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats. This is the well-established rule of law protecting both the public and the trade-mark owner.”).

and distinguish goods or services; therefore to afford trademark protection to a generic term would be to afford a property right when not warranted.¹⁰⁰ When a mark becomes generic through genericide, allowing continued trademark rights for the trademark owner would serve to protect only the property right to the detriment of the consuming public.¹⁰¹ In this way, genericide acts chiefly as a consumer-protection mechanism.

If the genericide doctrine continues to function improperly with regard to the Internet, courts risk allowing overprotection of trademarks in disregard of the goals of trademark protection. In practice, trademark overprotection implicates a series of dangers to the economic efficiency of trademark law.¹⁰² For instance, overprotection can have significant anticompetitive effects, allowing trademark property rights beyond a warranted amount to a trademark holder—a barrier that would act as a detriment to an otherwise deserving competitor.¹⁰³ Overload of rights could manifest in the form of lawsuits that might “provide a potent legal weapon against commercial competitors, disrupting the marketing of new, competing products.”¹⁰⁴

In addition, by allowing trademark rights beyond what is envisioned in the dual-purpose policy of trademark law, these overprotections may interfere with traditional First Amendment interests of freedom of expression.¹⁰⁵ Overprotection would also have the negative effect of hindering technological development, an issue that is especially relevant in the Internet context.¹⁰⁶ This may manifest in

¹⁰⁰ *Id.*

¹⁰¹ *Id.*

¹⁰² See Margreth Barrett, Internet Trademark Suits and the Demise of “Trademark Use,” 39 U.C. DAVIS L. REV. 371, 450 (2006).

¹⁰³ *Id.* (“As traditionally conceived, trademark law strikes a careful balance to ensure that genuinely deceptive (and more recently, dilutive) uses of marks, which increase consumer search costs, are prohibited, while uses to critique or compare the mark owners’s [sic] products and thus enhance the flow of useful information to consumers are permitted. Overprotection skews that balance, leading to the suppression of information essential to a properly functioning market.”)

¹⁰⁴ *Id.*

¹⁰⁵ *Id.* at 450-51.

¹⁰⁶ See *id.* at 451; Dogan and Lemley, *supra* note 97 at 831-32.

missed developmental opportunities and subpar progress in terms of efficient search algorithms and other mechanisms that can reduce consumer search costs.¹⁰⁷ With the speedy progress of the Internet, courts should be extremely reluctant to slow the progress of a tool that affords consumers lower search costs by granting unwarranted over-protections to trademark holders.

C. CONTEXT MATTERS WHEN EVALUATING TRADEMARK ISSUES

Further support for the notion of a modern tailoring for the genericide doctrine when applied to the Internet is found in the prevailing notion of the importance of context in trademark law.¹⁰⁸ As leading trademark scholars Graeme B. Dinwoodie and Mark D. Janis note: “Context is the means by which courts have traditionally constrained the scope of trademark law and trademark rights.”¹⁰⁹ Contextualism maintains its importance in trademark law because it allows for “transparent development” of the law.¹¹⁰ While many different issues are inherent in the discussion of trademarks, from dilution to the facilitation of economic expansion, it is only by considering and understanding the context of any given situation that competing interests in trademark can be properly weighed and evaluated.¹¹¹

In addition, relevant case law shows clear support for the importance of context. Judge Henry Friendly discussed the importance of context when considering the possible genericness of the word “safari” in *Abercrombie and Fitch v. Hunting World*.¹¹² He noted that “safari” could not be a trademark for an expedition into the African wilderness, as this is a common generic understanding of the word.¹¹³ He then was tasked with considering whether the word

¹⁰⁷ Barrett, *supra* note 102, at 452; Dogan and Lemley, *supra* note 97 at 831-32.

¹⁰⁸ See Graeme B. Dinwoodie and Mark D. Janis, *Confusion Over Use: Contextualism in Trademark Law*, 92 IOWA L. REV. 1597, 1658 (2007) (“Contextualism is a better alternative than the formalism of trademark use and has always been important in trademark law.”).

¹⁰⁹ *Id.*

¹¹⁰ *Id.* at 1659.

¹¹¹ *Id.*

¹¹² *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 (2d Cir. 1976).

¹¹³ *Id.*

“safari” when attached to clothing and other items was generic.¹¹⁴ The evidence showed that “safari,” when dealing with clothing, in the United States has come to mean a specific type of fashion apparel, thus making the “safari hat” and “safari jacket” generic terms.¹¹⁵

However, this line of reasoning did not necessarily control when applied to the usage of “safari” in connection with a boot.¹¹⁶ Judge Friendly considered the context in which the seller of the “safari boot” was selling its product by noting Lee Expeditions, Ltd., the parent company of Hunting World, Inc., had primarily been engaged in arranging safaris to Africa.¹¹⁷ Judge Friendly ruled that Hunting World was entitled to a fair use defense of infringement on Abercrombie’s “safari” trademark because the company had used the mark in the context of hunting and traveling expeditions and not as an attempt to trade on the good will of Abercrombie & Fitch.¹¹⁸

Abercrombie illustrates the importance of evaluating context when considering such trademark issues as distinctiveness, fair use, and a likelihood of confusion; however, the importance of context is not limited to these areas. This adherence to contextualism is inherent in all aspects of trademark law and should likewise be considered when evaluating the rules and tests designed to enforce it. In short, the fundamental importance of evaluating trademark issues with the proper context support the notion that the genericide doctrine should also be considered according to the context in which it is applied. The context of the Internet medium, both in usage and in consumer understanding, differs greatly from the economic realities of non-internet trademark usage. Because of this, a tailored approach to

¹¹⁴ *Id.*

¹¹⁵ *Id.* at 11-12 (“What is perhaps less obvious is that a word may have more than one generic use. The word ‘Safari’ has become part of a family of generic terms which, although deriving no doubt from the original use of the word and reminiscent of its milieu, have come to be understood not as having to do with hunting in Africa, but as terms within the language referring to contemporary American fashion apparel. These terms name the components of the safari outfit well-known to the clothing industry and its customers: the ‘Safari hat’, a broad flat-brimmed hat with a single, large band; the ‘Safari jacket’, a belted bush jacket with patch pockets and a buttoned shoulder loop; when the jacket is accompanied by pants, the combination is called the ‘Safari suit’. Typically these items are khaki-colored.”).

¹¹⁶ *Id.* at 12.

¹¹⁷ *Id.*

¹¹⁸ *Id.*

determining genericide in the Internet context is appropriate and necessary to truly give effect to the goals of the doctrine.

III. PROPOSED UPDATES TO THE TRADEMARK GENERICIDE DOCTRINE WHEN APPLIED TO THE INTERNET

For a modern inquiry into the possibility of whether a distinctive internet-based mark has become generic, there are both new areas of inquiry to explore and older considerations that should receive diminished importance. As this section will explain, the avoidance strategy rule against using trademarks as a verb should be abandoned and the power of any evidence of this linguistic shift should be ignored as indicative proof of genericide. Conversely, courts should perform an enhanced exploration into a new and important area of Internet commerce: the amount and effect of integration with third-party applications for services on the internet.

A. ABANDONING THE RULE AGAINST USING TRADEMARKS AS VERBS

The first adjustment that should be made to the genericide doctrine is a rejection of the extra-judicial ban on trademarks as verbs expounded by commentators. Because consumers can use a trademark as a verb and still understand the mark to have source-indicating function, this “rule” should be abandoned and not considered by courts as evidence of genericide.

Of all the commonly expounded genericide avoidance rules, none is currently so ignored by modern marketing as the linguistic decree, “NEVER use a trademark as a verb.”¹¹⁹ In practice, the anti-verbing rule expects that one should not “Rollerblade” to the store, but should ride ROLLERBLADE brand in-line skates to the store. To align with the avoidance strategies, the owners of the ROLLERBLADE mark, Nordica, should never advertise or use their mark in this way. The reason for the ban is that verb-style use of a trademark indicates a

¹¹⁹ International Trademark Association, Fact Sheets: Introduction to Trademarks, <http://www.inta.org/TrademarkBasics/FactSheets/Pages/TrademarkUseFactSheet.aspx> (last visited Apr. 19, 2011). *See also* International Trademark Association, A Guide to Proper Trademark Use for the Media and Publishing Professionals, <http://www.inta.org/TrademarkBasics/Documents/INTATMProperUse.pdf> (last visited Apr. 19, 2011) (“Trademarks and service marks are proper adjectives. Not nouns. Not verbs. A mark should always be used as an adjective qualifying a generic noun that defines the product or service. A mark is a company brand name, not a product or service itself. As adjectives, marks should not be used as plurals or in the possessive form, unless the mark itself is plural or possessive (such as 1-800-FLOWERS, MCDONALD’S or LEVI’S).”).

generic understanding of the mark—that the mark is no longer a source-indicator but acts instead as an indicator of a type or genus of a product.

However, recently there has been a rise in the use of trademarks as verbs, even to the point of brands, such as Microsoft's BING, deliberately marketing their trademarks as verbs.¹²⁰ For instance, BING has been advertised to consumers to suggest that instead of performing a search on the internet, the consumer should "Bing it."¹²¹ If this type usage of a trademark is so dangerous, then why are some brands allowing it?

There are several likely answers to that question. First, companies may put a premium on the proliferation of a brand over possible future legal consequences. If a trademark becomes so ubiquitous as to risk genericide, then in one manner of thinking, the brand has succeeded. Bing in particular is competing with Google, a company whose trademark many consumers have adopted as a verb meaning to perform an internet search using a search engine.¹²² Therefore, to convince consumers to use BING rather than GOOGLE, Microsoft actually may be forced to replace the action verb of "googling" with a new word, hence the verbing of "bing."¹²³ From this perspective, breaking this rule of the avoidance strategies is simply a calculated risk.

However, if we look deeper beneath the calculated risk of such usage of a trademark, several other truths begin to emerge. First, "verbing" is a specific linguistic action that has gained accelerated usage in modern English discourse. Defined, verbing is the turning of a noun or other type of speech into a verb.¹²⁴ It can be used as a way as create word play, to create new words, or to simplify existing speech.¹²⁵ While some linguist mavens decry such manipulation of the

¹²⁰ The Cajun Boy, *Microsoft Wants You to 'Verb Up' and 'Bing It,'* GAWKER, May 29, 2009, <http://gawker.com/5272444/microsoft-wants-you-to-verb-up-and-bing-it>.

¹²¹ *Id.*

¹²² *Id.*

¹²³ *Id.*

¹²⁴ Richard Nordquist, *What is Verbing?*, ABOUT.COM, <http://grammar.about.com/od/grammarfaq/f/verbingfaq.htm> (last visited Apr. 19, 2011). While trademarks are technically adjectives, they are often used by people as nouns to refer to companies and for this discussion, the analysis of verbing nouns and adjectives functions essentially the same way.

¹²⁵ *Id.*

English language, its effect on the language is clear, as words like contact, impact, access, party, author, and text are words that began as nouns and have become commonly accepted as verbs.¹²⁶ Because time and communication are at a premium, the public is quick to adopt quicker ways to communicate,¹²⁷ and verbing offers a useful tool for this.

In addition, the power of verbing as a marketing tool is clear. Marketing has the goal of selling products or services and modern marketers understand that to do this, the brand must connect emotionally with consumers.¹²⁸ As one commentator explains, “People care much more about verbs than nouns. They care about things that move, that are happening, that change. They care about experiences and events and the way things make us feel...Verbs are about wants and desires and wishes.”¹²⁹ Another commentator notes, “I love brands as verbs. They’re alive. They convey a sense of action and motion. They’re all about getting things done. They suggest a unique experience.”¹³⁰ As these marketing theorists argue, the use of a verb is perhaps the strongest way to market a product or service. A strong example of this power in action is GOOGLE. While Google has begun fighting the use of its mark as a verb, it is difficult to discount the power of its brand recognition as consumers continue to “google” their inquiries.¹³¹

But what about genericide? Is the verbing of a trademark really a good indication that a mark has lost its distinctive qualities? As the following will show, the verbing of a trademark is not a strong indication of generic understanding by the public and thus should not be considered by courts in a modern genericide analysis. In the United

¹²⁶ See *id.* (“Verbing weirds language.”).

¹²⁷ See Dreyfuss, *supra* note 65, at 414.

¹²⁸ Emotion vs. Logic in Sales, Marketing, and Advertising, <http://www.perrymarshall.com/marketing/m11/> (last visited Apr. 19, 2011).

¹²⁹ Seth Godin’s Blog, Nouns and Verbs, http://sethgodin.typepad.com/seths_blog/2005/04/nouns_and_verbs.html, (Apr. 21, 2005).

¹³⁰ David Cameron’s On Brands Blog, Brandverbing Brands, <http://onbrands.wordpress.com/2009/06/06/brandverbing-brands/> (June 6, 2009).

¹³¹ Alex Mandossian’s blog, Why is Google Unhappy About Getting “Verbed,” <http://www.alexmandossian.com/2009/01/13/why-is-google-unhappy-about-getting-verbed/> (Jan. 13, 2009).

States there is no history of any trademark being subject to genericide because of verbing alone. Additionally, it is likely that consumers can use a trademark as a verb and yet still understand the source-indicating function of it.

First, the legal power of verbing has been greatly overstated by the arbiters of the genericide avoidance strategies. Rose Hagan argues that the semantic rules of the genericide avoidance strategies are essentially “myths.”¹³² She notes that the Lanham Act shows no indication that trademarks are only to be used as adjectives, only that “the mark serve[s] a source-identifying function.”¹³³ Additionally, the USPTO has allowed the registration of trademarks as verbs, an example of which is every law school librarian’s favorite term, “Shepardize.”¹³⁴ Finally, Hagan proffers that no court has held that a trademark has gone from being distinctive to generic through verbing alone.¹³⁵

Next, the idea that using a trademark as a verb indicates a shift towards genericide assumes that the public cannot use a trademark as a verb without losing the understanding of source-indication. Recent history has proven this assumption false. People continue to “google” and most still understand that GOOGLE is a brand and trademark. In fact, by using the term as a verb, consumers are likely still referring to using the GOOGLE search engine and not as a generic term for performing an Internet search.¹³⁶

Also, consider eBay, a company whose namesake service allows users to buy and sell items in an online auction format. If someone plans to sell an antique plate and a friend suggests that he or she “eBay it,” this statement gives no indication that the giver or receiver of the advice does not understand that the trademark implications of EBAY. In fact, the presumption should be that people *do* understand the source-indicating function of trademarks when used as a verb. However, because it is not clear by this verb usage whether the source-indicating function is lost, evidence of verbing is not enough to claim

¹³² Hagan, *supra* note 82.

¹³³ *Id.*

¹³⁴ *Id.*

¹³⁵ *Id.* Some courts have considered verbing as evidence of genericness, but as evidence that the term was generic from the beginning, such as “IM,” the abbreviation for “instant messaging.” *America Online, Inc. v. AT&T Corp.*, 243 F.3d 812, 823 (4th Cir. 2001).

¹³⁶ Example: “No, don’t use Bing, Google it.”

that a mark is generic. Because of this, evidence of verbing is now so unpersuasive that courts should not even consider it when analyzing the possibility of genericide of an internet-based mark.

In addition, the disseminators of the conventional genericide avoidance strategies should release their stranglehold on the usage of trademarks as verbs. Because verb usage does not necessarily imply generic understanding of a trademark and because it is such a powerful marketing tool, brands should feel free to use their marks in any way they see fit. Rather than avoid certain types of usage altogether, brand owners should consider the overall scope and presentation of their marks, using them in ways that make clear that the mark represents their goods and services rather than those of their competitors.¹³⁷

B. GREATER SCRUTINY OF THE EFFECTS OF THIRD-PARTY INTERNET BRAND INTEGRATION ON THE PUBLIC'S UNDERSTANDING OF A TRADEMARK

The next adjustment calls for specific tailoring to the genericide inquiry when the trademark is attached to an internet service that allows third-party integration. When this usage is present, the presentation and consistency of the trademark as used by third-party developers should be considered for signs of generic understanding by the public. If the presentation is inconsistent and confusing, marked by varying levels of control exhibited by the trademark holder, this could be compelling circumstantial evidence of potential generic understanding by the relevant consuming public. This element shares a similar spirit with the trademark doctrine of naked licensing and the quality control requirement, where a trademark may be considered abandoned (resulting in loss of the rights) by the trademark holder if the holder gives licenses freely and does not maintain quality control.¹³⁸

¹³⁷ Hagan, *supra* note 82 (“Trademark lawyers should encourage steps that make the primary significance of the trademark as trademark clear, such as the use of slogans that clearly distinguish that verb from the name of the category (e.g., ‘Stop Cleaning. Start Swiffering’)”).

¹³⁸ *Stanfield v. Osborne Industries, Inc.*, 52 F.3d 867, 871 (10th Cir. 1995) (“Naked (or uncontrolled) licensing of a mark occurs when a licensor allows a licensee to use the mark on any quality or type of good the licensee chooses. *McCarthy* ...§ 18.15 (“Such uncontrolled licensing can cause the mark to lose its significance. When “a trademark owner engages in naked licensing, without any control over the quality of goods produced by the licensee, such a practice is inherently deceptive and constitutes abandonment of any

The internet offers new possibilities for the integration of brands, products, and services, and therefore, corresponding trademarks. While brand integration has always existed, in the Internet marketplace it has taken on an enhanced form, operating at greater levels of both occurrence and depth of integration. A particular type of integration that has had expansive growth in the computer and internet mediums is the advent of third-party applications, which “are programs written to work within operating systems, but written by individuals or companies other than the provider of the operating system.”¹³⁹

While third-party add-ons to physical goods have always existed—for instance, in products like third-party cell phone cases—in the computer and internet medium, third-party applications are both easier to develop and more likely to improve the experience of the original operating system. Some operating systems, such as the main systems behind Microsoft and Apple, are closed-sourced, meaning that a company that wants to create third-party applications must license the original operating system and is thus under careful scrutiny by the operating system owner.¹⁴⁰ However, other operating systems are open-sourced, meaning the access and ability to create third-party applications are freely available, although they may be subject to some limitations by the operating system owner.¹⁴¹ The amount of open-source systems and the corresponding third-party integration is growing.¹⁴²

Many of the major players in the Internet marketplace offer either open-source systems or leniently allow third-party applications to be developed. For instance, eBay, Firefox, Apple’s iTunes store, Facebook, and Twitter are just few of the internet companies that allow third-party developers to create programs that interact with their services. In addition, the amount of integration is staggering. At the time of publication of this note, Apple advertises over 350,000 applications (most of them developed by third parties) in its iTunes

rights to the trademark by the licensor.” *First Interstate Bancorp v. Stenquist*, 16 U.S.P.Q.2d (BNA) 1704, 1706, 1990 WL 300321 (N.D. Cal. July 13, 1990).”).

¹³⁹ R. Kayne, *What Are Third Party Applications?*, WISEGEEK, Nov. 3, 2010, <http://www.wisegeek.com/what-are-third-party-applications.htm>.

¹⁴⁰ *Id.*

¹⁴¹ *Id.*

¹⁴² *Id.*

store.¹⁴³ Twitter boasts of over 100,000 applications using its “Application Programming Interface.”¹⁴⁴ Facebook also allows third-party applications, and online tutorials exist showing how such a program can be created in under five minutes.¹⁴⁵ When successful, these third-party applications add to user experience by providing additional features to the original program in a way that does not add cost to the original provider.

However, in contrast to the economic positives of third-party applications, the possibilities of trademark confusion exist and could ultimately lead to generic understanding of a mark by the public. This type of confusion could be caused in two main ways by third-party applications: first, by irresponsible use of the trademark by the third-party developer and second, by confusing integration with other internet services and their trademarks.

Third-party programs can use the trademarks of the original program in irresponsible ways by manipulating logos, implying false endorsements, or by naming the third-party application in a way that supports a generic understanding of the mark. For instance, consider a hypothetical third-party application for eBay that helps to generate an aesthetically pleasing presentation of items a person is selling on ebay.com in a way that can be placed on the person’s personal website. Now, what if the program is named “Ebay Your Website,” and uses a manipulated EBAY logo sharing little similarity to the original? Because the logo is different, the name has been used in a generic way, and the eBay service is being viewed on an outside website, the public could start to believe that “eBay” is a general term for an online auction and thus not an indication of the source website.

In addition, third-party applications that work to integrate two or more original programs could be particularly confusing to consumers. For instance, consider a third-party application that allows users to list their eBay auctions on Facebook. If there is any type of presentation that might lead the consumer to believe that one can “eBay an item on Facebook,” then consumers may come to understand the mark “ebay” as a word defining any online auction and not solely

¹⁴³ Apple iPhone, <http://www.apple.com/iphone/apps-for-iphone/#heroOverview> (last visited Apr. 19, 2011).

¹⁴⁴ Twitter Blog, <http://blog.twitter.com/2010/05/twitter-platform.html> (May 24, 2010, 8:05 PST).

¹⁴⁵ Building Facebook Apps – Video Tutorial, <http://www.youtube.com/watch?v=roOYZKsN3Yg&feature=related> (Sept. 30, 2009).

in connection with the specific website and company, hence causing genericide.

Many of these companies allowing third-party development offer guidelines and rules for the development of third-party applications and the corresponding use of the companies' trademarks. For instance, Python Software allows open source development of its PYTHON programming language, but has a Trademark Usage Policy on its website.¹⁴⁶ Some highlights of the policy include a ban on using its trademarks (1) to refer to any other programming language, (2) to be used in a way that may mislead or imply association with unrelated modules, tools, documentation, resources, or (3) to be used in ways that might confuse the community as to whether the PYTHON language is free and open source.¹⁴⁷ The document goes on to require permission from Python when using its language in a commercial setting and provides specific rules for the presentation of its trademarks.¹⁴⁸

This note advises companies who want to allow third-party applications to create guideline documents, such as the one created by Python Software, in order to protect their trademarks. However, it should be noted that a guideline is only a guide and the true question will come down to how well the initial program provider is overseeing the third-party applications built on their original programs.

In response, courts should consider the allowance of third-party development as an element in a genericide inquiry over an internet-based trademark. If the trademark owner is allowing third-party integration with its trademark, the court should consider how consistent and clear the proliferation of the mark is among these third-party applications. If the presentation is inconsistent and confusing, this could be strong circumstantial evidence of potential generic understanding of the trademark by the relevant consuming public.

IV. Applying the Updated Genericide Elements to Twitter

Of the several web-based companies that have recently come under scrutiny for the possibilities of genericide, the most interesting

¹⁴⁶ PSF Trademark Usage Policy: version 1.4, <http://www.python.org/psf/trademarks/> (last visited Apr. 19, 2011).

¹⁴⁷ *Id.*

¹⁴⁸ *Id.*

case is Twitter.¹⁴⁹ Due to Twitter's meteoric rise in the social networking market and the possibly confusing proliferation of its marks, it is probably the most likely of this current crop of genericide contenders to succumb to this fate. While this paper does not go so far to say that Twitter's marks are currently generic, evidence is available to show that it might now or in the future become so.

Twitter was created in 2006 and operates as a social networking site that allows only short updates limited to 140 characters or less.¹⁵⁰ The website describes itself as "a service for friends, family, and co-workers to communicate and stay connected through the exchange of quick, frequent answers to one simple question: What are you doing?"¹⁵¹ Twitter posts typically include anything from breaking news to pointless ramblings and posts can include dynamic content including links to images, video, and other websites.

As the popular social networking watchdog site Mashable.com explains, posts on the site have "evolved to more than everyday experiences, and take the shape of shared links to interesting content on the web, conversations around hot topics (using hashtags), photos, videos, music, and importantly, real-time accounts from people who are in the midst of a newsworthy event, crisis, or natural disaster."¹⁵² Statistically, Twitter has near 106 million registered users, with new users signing up at the rate of 300,000 per day, and the site enjoys 180 million unique visitors each month.¹⁵³ Twitter has become so ubiquitous that it is not unusual to see Twitter posts presented as sources of news on major news networks. In addition to the term

¹⁴⁹ Other websites that have been subject to genericide scrutiny in the media include Google, Bing, and Yahoo. See Noam Cohen, *The Power of the Brand as Verb*, N.Y. TIMES, July 18, 2009, available at http://www.nytimes.com/2009/07/19/weekinreview/19cohen.html?_r=1.

¹⁵⁰ *What is Twitter?*, MASHABLE, <http://mashable.com/what-is-twitter/> (last visited Apr. 19, 2011). For more background on using Twitter, Mashable has published a highly detailed internet "guidebook" for using Twitter. *The Twitter Guide Book*, MASHABLE, <http://mashable.com/guidebook/twitter/> (last visited Apr. 19, 2011).

¹⁵¹ *Id.* Twitter has since updated its prompt question to "What's happening?" See Twitter, <http://www.twitter.com/> (last visited Apr. 19, 2011).

¹⁵² *Id.*

¹⁵³ *Twitter User Statistics REVEALED*, HUFFINGTON POST, Apr. 14, 2010, http://www.huffingtonpost.com/2010/04/14/twitter-user-statistics-r_n_537992.html [hereinafter *Twitter User Statistics*].

“twitter,” the website also promotes the use of the word “tweet,”¹⁵⁴ which is used as a verb to indicate what one does on Twitter when posting.¹⁵⁵ Because Twitter uses both the TWITTER mark and the TWEET mark, this paper will discuss the issues of both marks in this analysis.

The following analysis of Twitter’s trademarks will first consider traditional elements associated with determining the primary significance of the mark to the public, including: 1) media usage and 2) Twitter’s own usage of its marks. While surveys are part of the traditional elements of genericide and are helpful to gauge the public’s understanding of a trademark, that type of analysis is outside of the scope of this paper and thus will not be discussed.

After a look into the traditional factors, I will apply the new factors proposed by this paper to Twitter’s trademarks. First, I will discuss the changes to the treatment of verbing, followed by an analysis of the use of Twitter’s trademarks by third-party developers. The traditional element of analyzing competitor usage of a mark is closely related to the usage by third-party developers and will be discussed along with this new element.

A. TRADITIONAL ELEMENTS OF THE PRIMARY SIGNIFICANCE TEST

1. EVIDENCE OF GENERIC USAGE BY THE MEDIA

The media has recognized the value of the words that Twitter has introduced into the modern lexicon. In 2009, “tweet” beat out words like “fail,” “public option,” “H1N1,” and “sexting” to be named Word of the Year by the American Dialect Society.¹⁵⁶ It is interesting to note that at the same time, the term “google” was given the award for word of the decade.¹⁵⁷ Since Google has come under genericide scrutiny because of media usage such as this, the company has worked to

¹⁵⁴ And subsequently, “retweet.”

¹⁵⁵ For instance, rather than saying, “I posted on Twitter about running into him at the store,” a Twitter user would say, “I tweeted about running into him at the store” or “I twittered about running into him at the store.”

¹⁵⁶ Dave Parrack, *‘Google’ Named Word of the Decade, ‘Tweet’ Named Word of the Year*, TECH.BLORGE, Jan. 11, 2010, <http://tech.blorge.com/Structure:%20/2010/01/11/google-named-word-of-the-decade-tweet-named-word-of-the-year/>.

¹⁵⁷ *Id.*

inform the media of the trademark significance of its mark and adopted strict usage requirements for itself.¹⁵⁸

Usage of Twitter in the media is ubiquitous, as tweets are often presented in news reports, lampooned on late-night talk shows, and integrated into company advertisements. One example of how Twitter's marks are used generically in the media is the professional sports world, where Twitter has become quite popular for players, teams, and commentators. A poignant instance is in an Espn.com article regarding the falling out between the San Diego Chargers and their former cornerback, Antonio Cromartie.¹⁵⁹ After a list of other mistakes made by the player, the article states, "He was disciplined by coach Norv Turner for breaking team rules regarding tweeting from the team premises."¹⁶⁰ Again, disregarding the non-clarity over whether Twitter is trying to protect "tweet," the article uses the mark in a generic way. It is being used uncapitalized without any reference to a brand name or specific website. His act is presented as simply breaking a rule, and at no point would someone unfamiliar with the service realize that it referred to a specific website and service provider.

In late night talk-show programming, Twitter is popular fodder for jokes and satire. However, usually when presented, it is at no time apparent that TWITTER is a brand name and could easily be understood to be a generic activity of posting communication publicly on the Internet through a computer or mobile device. In the fall of 2009, Jay Leno interviewed Bill Cosby on his show and Mr. Cosby jokingly discussed his attempts at using—and even understanding—Twitter.¹⁶¹ He begins by discussing the linguistic usage of the word, stating, "I don't know if you conjugate it or if it's a noun. But, I do know that I don't like to say to anybody, especially a man, that I'm 'going 'tweety.'"¹⁶² He continues, "So my wife put me on the Tweeter. I don't know what I'm doing. I'm tweeting people on the twooty. Then, my granddaughter comes and says, 'are you tweeting?' I said no, you

¹⁵⁸ Ahrens, *supra* note 78.

¹⁵⁹ See *Former All-Pro Cromartie Headed to Jets*, ESPN.COM, Mar. 5, 2010, <http://sports.espn.go.com/nfl/news/story?id=4967508>.

¹⁶⁰ *Id.*

¹⁶¹ Bill Cosby Isn't Feelin' Twitter! (Talks to Jay Leno About Twitter), transcript on file with author.

¹⁶² *Id.*

pay for it.”¹⁶³ While his confusion was likely feigned for comedic purpose, the root of the joke is the public’s own misconception about the service. Simply, if the popular public perception were not that Twitter is confusing, then the jokes would not be funny. At the risk of being too lawyerly, the audience’s laughter proves the comedic success of the jokes.

As noted in the introduction of this note, on February 16, 2010, while speaking at the Tea Party Convention in Arkansas, Sarah Palin referenced Twitter in a generic way.¹⁶⁴ Responding to an audience member’s cry of “Obama!,” Palin replied by saying, “See, they said that, I didn’t. Just you watch now, too, because somebody will be here with their little Twittering thing, and it’s going to be on the Internet any minute now.”¹⁶⁵ Ms. Palin’s reference here is very much a generic usage of Twitter’s trademark because it equates the verb “twittering” with a quick communication posted publicly on the internet through a mobile device.¹⁶⁶ From her statement, any mobile device that can post on the internet is a “Twittering thing.” Again, nothing here signifies the source-identifying feature of the trademark and her usage actually suggests generic understanding.

In response to possible generic or confusing usage of its service and trademarks, Twitter has promulgated a series of guidelines on how to properly reference and refer to its service.¹⁶⁷ In general, its

¹⁶³ *Id.* For more late-night talk show lampooning of Twitter see Conan O’Brien’s Twitter Tracker, CoCo’s Cream of Tweet, Feb. 12, 2010, <http://www.youtube.com/watch?v=KZGSc41jqfs>, and another Jay Leno bit, Jay Leno’s Funny Twitter Joke, Apr. 26, 2009, <http://www.youtube.com/watch?v=izg4frvx5NM>.

¹⁶⁴ Conroy, *supra* note 1.

¹⁶⁵ *Id.* The capitalization of “Twittering” was provided by the writer of the article and would not have been apparent by Ms. Palin’s speech. Additionally, it should be noted that Ms. Palin maintains an active Twitter account. Sarah Palin’s Twitter Account, <http://www.twitter.com/SarahPalinUSA> (last visited Apr. 19, 2011).

¹⁶⁶ It could be argued that this simplistic understanding of TWITTER does not truly represent a generic representation of the mark. If one defines generic understanding of TWITTER more narrowly; as any type of internet service that allows 140 character updates in a timeline, then Ms. Palin’s representation does not quite meet this stringent characterization. However, I would argue for the less restrictive definition of the generic meaning of TWITTER, that any usage made to signify a quick communication posted publicly on the internet through a computer or mobile device, is evidence of generic understanding of TWITTER.

¹⁶⁷ See Guidelines for Use of the Twitter Trademark, <http://support.twitter.com/groups/33-report-a-violation/topics/121-guidelines-best-practices/articles/77641-guidelines-for-use-of-the-twitter-trademark> (last visited Apr. 19, 2011); see Guidelines for Use of Tweets in

guidelines stress the importance of using the word TWITTER to link to an account and using a current Twitter logo to link to the website.¹⁶⁸ It asks that when referencing the service, use TWITTER, but when talking about a Twitter post, use TWEET.¹⁶⁹ In addition, it asks that the word “Twitter” always be capitalized.¹⁷⁰

In its “Guidelines for Use of Tweets in Broadcast or Other Offline Media,” Twitter specifically addresses how it would like the media to use its trademarks. It asks that the Twitter logo be placed at a reasonable size next to any TWEETS shown, and that if a TWEET is read on-air, it should be attributed to TWITTER.¹⁷¹ Next, it includes an outline on how to include a reference to Twitter when referencing specific usernames. Importantly for purposes of genericide, it recommends that “If co-mingling Tweets with other content or updates from other sources, identify each individual Tweet as a Tweet by using the Twitter logo or T icon.”¹⁷²

These guidelines offer a reasonable approach to the trademark issues Twitter faces, and there is evidence that the media is listening.¹⁷³ Despite any generic usage of Twitter’s marks by the media, the existence of these guidelines should be viewed by a court as supporting the continued distinctiveness of those marks. However, it will be up to Twitter to maintain these guidelines and make specific requests to members of the media when the marks are used in a generic way.

Broadcast or Other Offline Media, <http://support.twitter.com/articles/114233-guidelines-for-use-of-tweets-in-broadcast-or-other-offline-media> (last visited Apr. 19, 2011).

¹⁶⁸ Guidelines for Use of the Twitter Trademark, *supra* note 167.

¹⁶⁹ *Id.*

¹⁷⁰ *Id.*

¹⁷¹ Guidelines for Use of Tweets in Broadcast or Other Offline Media, *supra* note 167.

¹⁷² *Id.*

¹⁷³ *E.g.*, *New ‘American Idol’ Judges to be Named Today*, CNN, Sept. 22, 2010, <http://www.cnn.com/2010/SHOWBIZ/TV/09/22/american.idol.judges/index.html?hpt=C2> (“Host Ryan Seacrest confirmed the impending confirmation in a Twitter post last week. ‘Looks like I have some new plans on wed!’ Seacrest tweeted. ‘I will be able to introduce the @AmericanIdol judges panel! We will send u a pic! Can’t wait” Note the clear demarcation of the communication as a “Twitter post,” with the capitalized “T.”).

2. EVIDENCE OF GENERIC USAGE BY TWITTER ITSELF

Twitter engages in several business practices where its own presentation of its marks could be confusing to the public and lead to a possible generic understanding of one or more of its marks. These practices include the inconsistent trademark registration status between TWITTER and TWEET, Twitter's differential treatment of its marks, and Twitter's lack of primary advertising to promote its service.

While Twitter has gained federal trademark registration for TWITTER, it has thus far been unsuccessful in obtaining a federal trademark right for the term TWEET.¹⁷⁴ Twitter filed an application to register the TWEET mark on April 16, 2009. However, the USPTO found that three other companies had already filed applications for trademarks that included "tweet" in their names and rejected Twitter's application based on its conclusion that there would be a likelihood of confusion between the marks.¹⁷⁵ While Twitter may attempt other ways to protect the "tweet" trademark, it seems to be abandoning the trademark registry approach. In July 2009, Twitter co-founder Biz Stone posted a blog entry explaining that Twitter would no longer police the usage of TWEET, but would continue to police TWITTER.¹⁷⁶

This approach may backfire on Twitter. By allowing one of its associated marks to become generic, and/or used by an unrelated third-party, Twitter may inadvertently weaken its other still-protectable marks. As Reid Wilson, Intellectual Property Counsel at Abercrombie & Fitch and Adjunct Professor of Trademarks at The Ohio State University Moritz College of Law, explained:

Trademark enforcement typically involves some amount of prioritization due to budget limitations. However, a strategy of selective enforcement that intentionally permits the unregulated use of one's trademark by an unrelated third-party, in what would be considered a "trademark" manner, will likely involve a material risk of harm to the trademark owner's

¹⁷⁴ Don Reisinger, *Not So Fast, Twitter: 'Tweet' isn't Yours*, CNET, Aug. 19, 2009, http://news.cnet.com/8301-17939_109-10313566-2.html.

¹⁷⁵ *Id.*

¹⁷⁶ Posting of Biz Stone, *May the Tweets Be With You*, <http://blog.twitter.com/2009/07/may-tweets-be-with-you.html> (Jul. 1, 2009, 10:37 A.M.).

portfolio as a whole by blurring the line between permissible and impermissible use of the mark. Particularly where two trademarks are new, arbitrary and clearly related, such as TWEET and TWITTER, the unregulated use of one is likely to suggest to third parties that they may freely use the other, which in turn would increase and complicate the owner's enforcement of the second trademark.¹⁷⁷

B. NEW FACTORS TO APPLY TO INTERNET-BASED TRADEMARKS

1. VERBING OF ITS TRADEMARKS WILL NOT WEIGH AGAINST TWITTER

As noted in part III.A, because consumers are likely able to understand a term as both a verb and a source-indicator, the traditional notion against the usage of trademarks as verbs should not weigh against Twitter. Twitter's marks TWITTER and TWEET are both often used as verbs by the media, the public, competitors, and third-party developers; however, this verb usage should not be considered evidence of genericide, and thus not weigh against Twitter in a genericide analysis.

2. EVIDENCE OF GENERIC UNDERSTANDING IN THIRD-PARTY APPLICATIONS AND COMPETITOR USAGE

As explained in part III.B, because of the strong possibilities of inconsistent proliferation that might lead to generic understanding, when internet services are engaged in wide-spread allowance of the development of third-party applications with their service, a court should analyze the consistency and clearness of the proliferation of the mark. Because Twitter actively allows and promotes third-party development of its service, this element is particularly relevant to a genericide analysis of Twitter's marks.

According to Tweeterland, a third-party website devoted to all things Twitter-related, nearly 200 standalone third-party programs interface directly with Twitter.¹⁷⁸ These include websites, phone

¹⁷⁷ Email Interview with Reid Wilson, Intellectual Property Counsel at Abercrombie & Fitch and Adjunct Professor of Trademarks at The Ohio State University Moritz College of Law (Mar. 9, 2010, 13:13 EST) (on file with author).

¹⁷⁸ Tweeterland Twitter Applications, <http://tweeterland.com/twitter-applications/> (last visited Apr. 19, 2011).

applications, email applications, media applications, and applications that link to other social media sites such as Facebook.¹⁷⁹ What makes analysis of these applications all the more relevant is that 75% of Twitter traffic comes from outside the Twitter.com website via third-party applications.¹⁸⁰ In addition, roughly 60% of all TWEETS come from third-party applications.¹⁸¹ Third-party applications are as much, or more of a part of Twitter's presentation to the public as its own website.

In response to the trademark denial of "tweet," co-founder Biz Stone responded with a blog post where he explained that Twitter has no intention of "going after" applications and services that use the word TWEET when associated with Twitter, but that if the term is used in a damaging or confusing way, he hints that the company would take action.¹⁸² He then goes on to politely explain that Twitter would not approve of third-party services and applications using TWITTER freely.¹⁸³

Similar to its guidelines regarding media usage of its marks, Twitter has issued guidelines for developers explaining how to both properly integrate with the service and properly use its trademarks.¹⁸⁴ Building on the general guidelines discussed previously in the media section, this document promotes the use of approved Twitter graphics with specified "clear space": "It is important that the logo has a clear space of one-third the size of the Logo around it on all sides. This maintains the integrity of the logo and avoids congestion and illegibility."¹⁸⁵ Next, it prohibits modification of the "Twitter Brand

¹⁷⁹ *Id.*

¹⁸⁰ *Twitter User Statistics*, *supra* note 153.

¹⁸¹ *Id.*

¹⁸² May the Tweets Be With You, <http://blog.twitter.com/2009/07/may-tweets-be-with-you.html> (Jul. 1, 2009, 10:37 PST) ("In fact, we encourage the use of the word Tweet. However, if we come across a confusing or damaging project, the recourse to act responsibly to protect both users and our brand is important.").

¹⁸³ *Id.* ("When folks ask us about naming their application with "Twitter" we generally respond by suggesting more original branding for their project. This avoids potential confusion down the line.").

¹⁸⁴ Twitter Developers Display Guidelines, http://dev.twitter.com/pages/display_guidelines (last visited Apr 20, 2011).

¹⁸⁵ *Id.*

Elements” and, importantly, prohibits any sense of endorsement between the Twitter marks and the third-party application.¹⁸⁶

Even with Stone explaining his company’s policy on third-party usage of its mark and its developer guidelines, its actual policing record has been, at best, based on the quality of the third-party usage and at worst, completely random. What follows are three publicized instances in 2009 of Twitter policing uses of its mark by third-party developers.

Shortly before Twitter was denied protection for TWEET by the USPTO, and Biz Stone’s subsequent blog post, an email conversation between Twitter and a third-party developer for a web-based service that was similar to Twitter’s web application was published on the TechCrunch blog.¹⁸⁷ An email from Twitter read: “Twitter, Inc is uncomfortable with the use of the word Tweet (our trademark) and the similarity in your UI and our own. How can we go about having you change your UI to better differentiate your offering from our own?”¹⁸⁸ It seems that Twitter was uncomfortable with this company using the TWEET mark because of the similarity in the look and feel of the program and not because of the use of the term itself. Therefore, Twitter’s policing effort here seem to suggest that it will allow third-party developers to use its marks only if the third-party service can be clearly differentiated from Twitter. However, this seems adverse to the logic of the genericide doctrine. If consumers regularly see the Twitter marks on secondary products that are clearly differentiated from Twitter, it follows that the consumer will soon begin to disassociate the Twitter trademarks as coming solely from the company Twitter.

In August of 2009, TechCrunch noted that even following the denial of trademark registration for “tweet,” Twitter began to aggressively protect TWEET and RETWEET.¹⁸⁹ The blog reported that Mesiah Lab’s “@retweet” account, which had been intended for use by

¹⁸⁶ Guidelines for Use of the Twitter Trademark, <http://support.twitter.com/forums/26257/entries/77641> (last visited Apr 20, 2011) (“Don’t...Imply sponsorship, endorsement, or false association with Twitter, Inc”).

¹⁸⁷ Robin Wauters, *Twitter Grows “Uncomfortable” With the Use of the Word Tweet in Applications*, TECHCRUNCH (July 1, 2009), <http://techcrunch.com/2009/07/01/twitter-grows-uncomfortable-with-the-use-of-the-word-tweet-in-applications/>.

¹⁸⁸ *Id.*

¹⁸⁹ Milo Yiannopoulos, *Has Twitter’s Aggressive Protectionism Come Too Late?*, TECHCRUNCH EUROPE (Aug. 16, 2009), <http://eu.techcrunch.com/2009/08/16/has-twitters-aggressive-protectionism-come-too-late/>.

a third-party service website called “Retweet.com,” had been suspended.¹⁹⁰ The blog also reported that Twitter began sending cease and desist letters to various people whom it believed were potentially infringing its trademarks; however again, it seemed to be based on visual similarity issues and not solely related to the use of Twitter’s trademarks.¹⁹¹

Then, in September of 2009, a popular third-party Twitter phone application for the iPhone mysteriously changed its name from “TwitterFon” to “Echofon.”¹⁹² Naan Studios, the developer behind the application, claimed that the name change was done in order to unify the names of its two products, “TwitterFon” and “TwitterFox” (a plug-in for the Firefox internet browser).¹⁹³ However, rather than change both names to either of those two names, Naan chose to pick a name completely unrelated to Twitter.¹⁹⁴ A writer for TechCrunch noted that this was more likely to confuse consumers and suggested that it was likely done to avoid any kind of legal problems with Twitter.¹⁹⁵

With knowledge of these policing efforts, it may seem that Twitter is attempting to maintain the distinctive integrity of its trademarks; however, third-party Twitter applications with “twitter” or “tweet” in the name are still numerous and seem to operate with the blessing of Twitter. Some applications with “twitter” or a slight variation in the name include Twittertise, Twit Response, Twitpic, Twixr, Twitter Poster, Twideo, Twitplus, Twittershare, TinyTwit, Twittermail, OuTwit, Vtwitter, Twitterific, and the list goes on.¹⁹⁶ With regards to TWEET, which Twitter has sometimes claimed to be policing and sometimes not, even more third-party applications use “tweet” in their

¹⁹⁰ *Id.* Twitter accounts have a user name and are delineated by the “@” symbol before the name. Simply, when you see “@” followed by a word or name, at Twitter username is signified.

¹⁹¹ *Id.*

¹⁹² MG Siegler, *Oddly, TwitterFon Changes Its Name to Echofon*, TECHCRUNCH (Sep. 14, 2009), <http://techcrunch.com/2009/09/14/oddly-twitterfon-changes-its-name-to-echofon/>.

¹⁹³ *Id.*

¹⁹⁴ *Id.*

¹⁹⁵ *Id.*

¹⁹⁶ Tweeterland Twitter Applications, *supra* note 178.

name than “Twitter.”¹⁹⁷ Therefore, these three instances of policing its trademark are not Twitter’s normal policing activity, but rather, represent the exceptions to its general non-policing activity.

One way that these specific third-party uses of Twitter’s trademarks could be dangerous to its distinctiveness is represented by services like Twitpic, whose service does not even require any linking to Twitter to be fully realized.¹⁹⁸ Twitpic is a photo hosting website that allows Twitter users to upload photos to its website and then link to the photo through a Twitter post.¹⁹⁹ The post then shows the URL including the domain “twitpic.com/,” letting users know that the link is a picture and hosted on the Twitpic website. However, the usage of Twitpic does not require using Twitter at all. A picture hosted on Twitpic, can be shared in a variety of non-Twitter ways including email, blogs, texts, and even on other websites such as Facebook. A user who receives links to pictures on Twitpic through an email might start to associate the TWIT mark as referring to any type of quick communication. Because the TWIT mark can be used completely separately from the Twitter website through this service, consumers could begin to understand TWIT in a generic way: a way that fails to support the source-indicating function of the mark.²⁰⁰

A particularly dangerous way that Twitter’s allowance of third-party integration may cause its mark to be understood by the public as a service-identifier rather than a source-identifier is the ability to link one’s Twitter account with other social networking sites. Quite simply, through applications on other social networking sites, third-party Twitter clients, or a number of other services, it is possible to update multiple social networking sites through one action.²⁰¹ What this means is that you can update Facebook and have it show up on Twitter as well, or vice versa. With a service like Ping.fm, you can

¹⁹⁷ *Id.*

¹⁹⁸ See Twitpic, <http://www.twitpic.com> (last visited Apr. 19, 2011).

¹⁹⁹ *Id.*

²⁰⁰ In contrast however, one cannot post to Twitpic without using a Twitter account first. Therefore, the user who posts pictures on Twitpic will likely understand the trademark association of the TWIT mark. But it is the non-Twitter using viewer who will suffer confusion from viewing pictures on Twitpic in a manner entirely unrelated to Twitter.

²⁰¹ Jennifer Van Grove, *Twitter to Facebook: 5 Ways to Post to Both*, MASHABLE (May 25, 2009), <http://mashable.com/2009/05/25/twitter-to-facebook/>.

actually link your Twitter page, Facebook page, Google Buzz, and personal blog all in one action.²⁰²

While this integration makes managing one's online presence streamlined and highly functional, it can easily cause problems in terminology. When you post on Twitter, you are "tweeting," but if you are posting simultaneously on Twitter and Facebook, you are still "tweeting," and in fact, you are now "tweeting on Facebook." Through a seemingly harmless physical act, the linguistic presence of generic usage becomes apparent. If one can "tweet" on a service other than Twitter, and this understanding is cemented in the public's collective mind, the term has become generic. By performing an internet search for the phrase "tweet on Facebook," it can be seen that people have begun using this terminology. Thus far, Twitter has not attempted to police this type of usage.

Additionally, the loose policing of the various types of third-party integration taking place with Twitter's trademarks could be considered evidence of trademark abandonment, a finding which causes cancellation of a trademark.²⁰³ The definition of "abandonment" in the Lanham Act states that "[a] mark shall be 'abandoned' if...[w]hen any course of conduct of the owner...causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark."²⁰⁴ Because these uses of the TWIT and TWEET marks could be construed as causing the terms to become generic names for the services with which they are associated, it could be argued that Twitter is in danger of committing trademark abandonment.

While Twitter's explanations and guidelines regarding its trademarks represent a reasonable effort to maintain the integrity of its marks through the development of third-party applications, its actual record of maintaining these rules is not flawless. Because of this, a court might find that the proliferation of its mark in these third-party applications is confusing to consumers and could support a generic understanding of its marks.

²⁰² *Id.*

²⁰³ Lanham Act § 14, 15 U.S.C. § 1064(3).

²⁰⁴ Lanham Act § 45, 15 U.S.C. § 1127.

3. CONCLUSION ON TWITTER GENERICIDE ANALYSIS

This Note does not go so far to claim that Twitter, or any of its related marks, are currently generic. A thorough analysis would be supplemented by surveys and further direct exploration into how the public understands the marks. However, it is clear that several of the following areas of Twitter's proliferation might lead to genericide: (1) the federal trademark protection of TWITTER, but not TWEET, and Twitter's subsequent differential enforcement of the two marks; (2) the media's occasional generic usage; (3) Twitter's selective policing of its mark among third-party developers and, related to that: (4) the ability to use third-party applications to simultaneously combine actions on Twitter with other websites; and (5) the public's low level of understanding of the service.

However, several factors support a conclusion that Twitter and its related marks have not yet succumbed to genericide. These include: (1) the well-reasoned and easily available guidelines for users, the media, and third-party developers to reference and interact with the service; (2) moderately strong and consistent protection of its main trademark, TWITTER; (3) a lack of direct competitor usage of the mark; and (4) no direct evidence that the mark is currently generic.

In summation, Twitter's trademarks are likely not currently generic, but because of the several issues outlined above, if Twitter is not careful, it is a real possibility that its marks could lose their source-indicating function and thus succumb to genericide. To avoid this finding, Twitter should focus on: (1) better policing of third-party developer's usage of its marks; (2) stronger protection of TWEET, even without federal registration; (3) disallowing third-party applications that allow simultaneous posting on Twitter and competing websites; and (4) working to educate the public about its service.

V. CONCLUSION

The genericide doctrine is an important element of trademark law, as it gives the public the ultimate say in controlling the lexicon. Because the judicial elements and case law were solidified in a pre-internet age, the current approach and accompanying avoidance strategies are out-of-sync with the realities of the internet marketplace. The philosophies behind trademark law support updating these doctrines when necessary, and therefore it is appropriate and necessary to update the genericide doctrine for use on the internet.

This Note proposes three major updates to the doctrine: (1) that verbing and other unconventional uses of trademarks is acceptable in the modern age because the public still understands the source-indicating function of trademarks used this way, and thus, should not be considered as evidence of genericide; (2) because of the new realities of integration with third-party developers and its subsequent dangers to trademark understanding, when internet trademark holders allow third-party development of its service, courts should consider how consistent and clear the proliferation of the marks are; and (3) because some members of the public who do not understand an internet service will likely not associate its trademark as a source-indicator, courts should consider how well the public understands a service when deciding whether the mark has succumbed to genericide.

Finally, this Note applied the updated genericide analysis to the popular social networking site, Twitter.com, concluding that TWITTER and its related marks have likely not yet become generic, but because of several of its actions, are at some risk of becoming generic in the future.